

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIP R. KRAUSE

Appeal No. 2006-0971
Application 09/524,590¹

HEARD: April 27, 2006

Before JERRY SMITH, BARRETT, and SAADAT, Administrative Patent Judges.

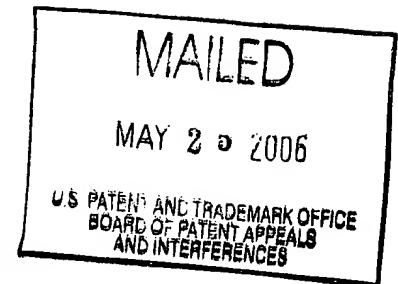
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 36-69.

We reverse.

¹ Application for patent filed March 14, 2000, entitled "Method and Apparatus for Enhancing Electronic Reading by Identifying Relationships Between Sections of Electronic Text," which is a continuation-in-part of Application 09/015,660, filed January 29, 1998, now U.S. Patent 6,154,757, issued November 28, 2000, which is based on and claims priority under 35 U.S.C. § 119(e)(1) from U.S. Provisional Application 60/036,305, filed January 29, 1997.



BACKGROUND

The invention relates to automatically formulating a search request based on displaying electronic text, performing a search that identifies conceptually related material, and displaying a link to the conceptually related material side-by-side with the electronic text.

Claim 36 is reproduced below.

36. A method for using a computer system, in response to a reader's request for display of electronic text, to automatically identify and provide additional reading material related to concepts referred to within said electronic text comprising, in sequence, the steps of:

- a) accessing, using the reader's computer, electronic text requested for display by the reader, said electronic text containing at least one text section;
- b) using said at least one text section to automatically formulate, on the reader's computer, a search request related to a concept referred to in said at least one text section;
- c) responsive to said search request, automatically searching an index, wherein
 - i) said index contains a plurality of terms by which it may be searched;
 - ii) substantially all terms in said index are associated with at least one pointer to a text section; and
 - iii) at least one term in said index is associated with a plurality of pointers, at least two of said plurality of pointers pointing to different text sections;
- d) responsive to step (c), automatically identifying additional reading material related to said concept; and

e) automatically displaying on said reader's computer display, an indicator of said additional reading material together with at least one link to a source of said additional reading material, side-by-side with a portion of the electronic text referred to in step (a).

THE REFERENCES

The examiner relies on the following references:

Meske, Jr. et al. (Meske)	5,530,852	June 25, 1996
Sotomayor	5,708,825	January 13, 1998
Boguraev	6,212,494	April 3, 2001

(effective filing date September 28, 1994)

THE REJECTIONS

Claims 36-41 and 43-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sotomayor and Meske.

Claim 42 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sotomayor and Meske, further in view of Buguraev.

We refer to the final rejection (pages referred to as "FR__") and the examiner's answer (pages referred to as "EA__") for a statement of the examiner's rejection, and to the brief (pages referred to as "Br__") and reply brief (pages referred to as "RBr__") for a statement of appellant's arguments thereagainst.

DISCUSSION

Appellant correctly approaches the obviousness issue based on the claim language, the Graham v. John Deere Co. factual inquiries, and the motivation factual inquiry. We reverse for the reasons set forth by appellant in the appeal brief and reply brief, in particular, for the four following reasons.

First, we agree with appellant's argument (e.g., Br9; RBr6) that the rejection fails to specify precisely what disclosures in the references correlate to the claim limitations and that the references do not, in fact, disclose the steps of the claimed invention. Appellant has not merely relied on the failure of the rejection to correlate the teachings of the references to the claim limitations, but has fairly tried to identify the sources of the limitations in the references and shows that most claim limitations are missing (claim chart at RBr9-13). As noted by appellant, the claims specifically recite that the steps must be performed "in sequence." We have thoroughly reviewed the references and the rejection and agree with appellant's findings in the claim chart (RBr9-13) that the claim steps are not found in either Sotomayor or Meske, except for accessing electronic text for display in step (a). If the examiner is relying upon some special claim interpretation or interpretation of the references, it has not been explained.

Second, we agree with appellant's argument (RBr17-18) that the statement of the motivation is a direct quotation from the field of invention of Meske, which provide no specific motivation to combine elements with Sotomayor to arrive at the claimed invention. Even if motivation existed, not all the steps are taught by Sotomayor and Meske and therefore, there is no way to combine the references to arrive at the claimed invention.

Third, as to the examiner's statement that it is proper to take into account not only specific teachings of the reference, but also the inferences which one skilled in the art would reasonably be expected to draw therefrom (EA17), we agree with appellant's reply (RBr6; RBr13) that that since the examiner has not identified any inferences beyond the express teachings of the references, it is appropriate to limit the analysis to the express disclosures in the references. The references do not teach or suggest all the steps of the claimed invention.

Fourth, we agree with appellant's argument (RBr14) that In re Bozek, cited by the examiner for the proposition that a conclusion of obviousness can be based on common knowledge and common sense, did not hold that common knowledge and common sense are a substitute for evidence. The examiner does not state what finding would be made by one skilled in the art based on common knowledge and common sense to either teach of the missing steps or to provide motivation. Again, the rejection must be based on

the express disclosures of the references, which we find do not support the obviousness conclusion.

Appellant's briefs are well written, cogent, and persuasive. We briefly comment on a couple of points for appellant's benefit in future cases. "Objective evidence" (RBr8) is a term used for certain recognized categories of evidence tending to show nonobviousness; e.g., long-felt need and failure of others, commercial success, commercial acquiescence and licensing, professional approval, copying, etc. It is not necessary for applicants to produce objective evidence of nonobviousness unless the examiner has established a prima facie case of obviousness. The kinds of things appellant discusses as objective evidence are better analyzed under some other factual finding. For example, "analogous art" corresponds to the "scope of the prior art." See Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983) ("The scope of the prior art has been defined as that 'reasonably pertinent to the particular problem with which the inventor was involved'."). The fact that the references are "individually complete" may be argued in connection with motivation as to why one would want to modify a reference. Motivation to combine the references is a question of fact drawing on the factors of Graham v. John Deere Co. and is a fifth factual inquiry. See McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001).

Lastly, although a "reasonable expectation of success" is stated to be one of the three criteria to establish a prima facie case of obviousness, Manual of Patent Examining Procedure § 706.02(j), this is seldom an issue in the mechanical and electrical arts, which are highly predictable; e.g., if the proposed modification was to program a computer to perform a step taught in another reference, there is no chance of failure. None of these comments on the fine points of patent law detracts from the exceptionally well-argued appeal.

For the reasons stated above, the rejection of claims 36-41 and 43-69 over Sotomayor and Meske is reversed. Buguraev does not overcome the deficiencies in the combination of Sotomayor and Meske and therefore, the rejection of claim 42 is reversed.

REVERSED

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Lee E. Barrett
LEE E. BARRETT

Administrative Patent Judge

Maahsid D. Shadab

MAHSHID D. SAADAT
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